



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,623	06/18/2001	Pavitra Subramaniam	5306P016	4377

8791 7590 03/21/2005

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT	PAPER NUMBER
----------	--------------

2161

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,623

Applicant(s)

SUBRAMANIAM ET AL.

Examiner

Haythim J. Alaubaidi

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the amendment filed on December 6, 2004.
2. Claims 1-31 are presented for examination following the amendment of December 6, 2004.
3. The Examiner withdraws the Double Patenting Rejecting.
4. Claims 1-31, stands rejected under 35 U.S.C. 101.
5. Claims 1-2, 4-17, 19-22 and 24-30, are rejected under 35 U.S.C. 102(e).
6. Claims 3, 18, 23 and 31, are rejected under 35 U.S.C. 103(a).

Response to Arguments

7. Applicant's arguments, filed December 6, 2004, with respect to the rejection(s) of claim(s) 1-31, have been fully considered and are persuasive. Therefore, the previous rejection of September 3, 2004, has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made with respect to Kessenich in view of Whitman.

a. In regard to Applicant argument on Pages 2-3 of the December 6, 2004 amendment for the 35 U.S.C. 101 rejection. The Examiner would like to direct the Applicant's attention to part (1) of the test, specifically the underlined text regarding the technology art. Per the 101 panel, the claims fail to specify a technology art which fails to comply with the first part of the test mentioned below. The claimed language is not within a technological arts (such as, a

computer implemented method or a computer method or caching the results in a computer memory), these claims do not specify the technological art, thus, it is deemed to be directed to non-statutory subject matter.

Terminal Disclaimer

8. The Examiner acknowledges the receipt of the Terminal Disclaimer filed on December 6, 2004. Hence, the Examiner hereby withdraws the Double Patenting Rejecting indicated in the previous Office Action of September 3, 2004.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 10, 16 and 21, are rejected under 35 U.S.C. 101 because the claimed invention stated in the claims is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

Art Unit: 2161

phenomena) that do not apply, involve, use, or advance the technological art fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman* (Ex parte *Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, claims 1, 10, 16 and 21 all recites an abstract idea at the preamble; in addition, the steps in the claim body merely applying a search and generating results, which can be implemented by the mind of a person or by the use of a pencil and paper. In other words, the claimed language is not within a technological arts (such as, a computer implemented method or a computer method or caching the

Art Unit: 2161

results in a computer memory), these claims do not specify the technological art, thus, it is deemed to be directed to non-statutory subject matter.

Claims 2-9, 11-15, 17-20 and 22-31 are also rejected as they inherent the deficiencies of there independent claims.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 (e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-2, 4-17, 19-22 and 24-30, are rejected under 35 U.S.C. 102(e) as being anticipated by John M. Kessenich (U.S. Patent No. 6,292,802 and Kessenich hereinafter).

Regarding Claims 1, 6-7, 10, 13, 16, 24 and 27, Kessenich discloses:

receiving search criteria¹ entered by a user (Figures 4-7, Elements 400-416), wherein the search criteria includes at least one keyword (Figures 4-7, Element 416; see also Col 6, Line 66 through Col 7, Line 5);

¹ Please note that Elements 400-416 of Figures 4-7 reads on the "criteria" limitation of claims 1, 10, 16 and 27; and also the type of search or the category of search, such as (symbols, keyword or files) (see Col 7, Lines 1-2) also reads on the criteria as a type of category of search. Elements 400-416 of Figures

Art Unit: 2161

searching a database for data record matching the search criteria (Col 7, Line 5-7 and Lines 12-14; see also Col 7, Lines 25-30);
generating search results (Col 7, Line 14-16 and Lines 32-43); and
caching the search result to maintain persistency of the search result (Col 18, Line 41-58).

Regarding Claims 2, 17, 22 and 28, Kessenich discloses wherein receiving search criteria further comprises receiving at least one search category (Col 7, Lines 1-2; see also footnote No. 1).

Regarding Claims 4 and 11, Kessenich discloses passing the received search criteria to a virtual business component (Figure No. 1, Element No. 106; see also Col 5, Lines 62-64; see also Col 6, Lines 20-24).²

Regarding Claims 5 and 12, Kessenich discloses passing the received search criteria from the virtual business component to a search execution business service (Figure No. 1, Element No. 104; see also Col 6, Lines 3-6).

Regarding Claims 8, 14, 19, 25 and 29, Kessenich discloses caching the search result until termination of a user session to maintain persistency of the search result (Col 18, Line 41-58)³.

4-7 are parameters relating to the search similar to what's in the Specification of the current application (see Page 41, Lines 20-23).

² Please note that according to the Specification of the current Application Page 41, Lines 6-14, i.e. external data) the VBC of Claim 4, reads on the external database 106 of Figure No. 1, especially since this database can reside on a remote node accessible through a network (Col 6, Lines 20-24).

³ Please note that the Kessenich's search is being performed through a web browser and the search results are being cached locally (Col 18, Lines 41-58) which inherently means that closing the web browser will terminate the cached results stored within.

Art Unit: 2161

Regarding Claims 9, 15, 20, 26 and 30, Kessenich discloses listing the search results (Figures 4-7; see also Figure 10, Element No. 1010).

Regarding Claim 21, the limitations of this claim was addressed in rejecting Claim 1, 4 and 5, as Claim 21 is a combination of the limitations of Claims 1, 4 and 5. it is therefor rejected as set forth above.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3, 18, 23 and 31, are rejected under 35 U.S.C. 103(a) as being unpatentable over John M. Kessenich (U.S. Patent No. 6,292,802 and Kessenich hereinafter) in view of Ronald M. Whitman (U.S. Patent No. 6,772,150 and Whitman hereinafter).

Regarding Claims 3, 18, 23 and 31, Kessenich discloses all of the claimed subject matter set forth above, including the feature of refining the search result (Col 13, Lines 29-33); Kessenich doesn't explicitly indicate using a keyword in refining a search result; though the feature of refining search results are notoriously well known, yet the

Art Unit: 2161

Examiner is incorporating a second reference for Whitman to leave no doubted that such a feature is unpatentable is it is well known in the art.

Whitman discloses refining the search result based at least on one keyword (Col 3, Lines 45-48; see also Col 6, Lines 22-25). Given the intended broad application of Kessenich's system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Kessenich with the teachings of Whitman to include the well known feature of using keywords in refining a search result as to further limit the search result to a more reasonable amount of returned results or records; the systems with such a feature would be more attractive to users to use and thus would lead to increase in profits as more users will be using such a system over another system that does not provide the ability to further limit a search result.

Points of Contact

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (571) 272-4014. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any response to this office action should be mailed to:

Art Unit: 2161

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered responses should be brought to the Customer Service Window of the Randolph Building at 401 Dulany Street, Alexandria, VA 22314

Haythim J. Alaubaidi

Frantz Coby
FRANTZ COBY
PRIMARY EXAMINER

Patent Examiner
Technology Center 2100
Art Unit 2161
March 15, 2005